

#7 L. Jr.
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PATENT
Attorney Docket No. 02481-0790-00000
(HOAG-790)

GROUP 180

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

DORSCHUG et al.)

Serial No.: 07/369,686)

Group Art Unit: 185

Filed: June 21, 1989)

Examiner: M. Porta

For: MINI-PROINSULIN, ITS)
PREPARATION AND USE)

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT AND
SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

In the Office Action dated April 10, 1991, the Examiner required restriction under 35 U.S.C. § 121 between the claims of Group I (claims 1-5, and 10) and Group II (claims 6-9).

Applicants provisionally elect to prosecute Group I, claims 1-5 and 10, with traverse.

Section 803 of the Manual of Patent Examining Procedure states the criteria for restriction between patentably distinct inventions, namely, the inventions must be independent, and there must be a serious burden on the Examiner if restriction is not required. In the instant case, the Examiner has not shown that there would be a serious burden if restriction is not required.

Moreover, MPEP § 703 also provides as follows:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it contains claims to distinct or independent inventions (Emphasis added).

In this case, the claims of the entire application are classified in only two (2) classes and two (2) subclasses, clearly not a serious burden. The restriction requirement should be withdrawn.

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Under the provisions of 37 C.F.R. §§ 1.56 and 1.99, applicants hereby submit the following additional information which the Examiner may consider to be material to the examination of the above-identified application.

1. U.S. Patent No. 4,608,364, by Grau,
issued on August 26, 1986.

The above document, cited on page 1, line 29 of the specification, relates to pharmaceutical agent for the treatment of diabetes mellitus. This patent corresponds to European Patent Application No. EP-A-0 132 769 which was cited in the European Search Report for Application No. EP 89 11 1027 corresponding to the above-identified U.S. application. A copy of the European application will be submitted to the Examiner if and when it becomes available.

2. European Patent Application No. EP-A-0 195 691,
Published on September 24, 1986.

The above document relates to insulin precursors, process for their preparation and process for the preparation of human

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insulin. This patent application was cited in the European Search Report for Application No. EP 89 11 1027 corresponding to the above-identified U.S. application.

Copies of these documents are being submitted along with Form PTO-FB-A820. Applicants respectfully request that the Examiner consider the enclosed documents and evidence that consideration by making the appropriate notations on the attached form.


Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the enclosed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
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By:


Raz E. Fleshner
Reg. No. 34,331

Date: May 9, 1991

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